

REMARKS

Claims 1-43 are pending, with claims 1, 19, 23 and 26 being independent. Claims 16, 26 and 41 have been amended. New claims 44-73 have been added. No new matter has been added. Reconsideration and allowance of the above-referenced application are respectfully requested.

Rejection of Claims - 35 U.S.C. § 101:

Claims 19-22 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. In particular, the Office asserts:

Claims 19-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 19 recite "a software product tangibly embodied in a machine readable medium..." The claim recitation does not permit the program functionality to be realized by claiming for example, "computer-readable medium encoded with computer executable instructions ...", as a computer element, which defines structural and functional interrelationships between the computer program and the rest of the computer or a set of instructions capable of being executed by a computer.

However, attention is called to the fact that claim 19 does not include the language cited by the Office. Rather, this language appears in claim 26.

Examiner Tung is thanked for the telephone interview conducted with Mr. Hunter on March 19, 2008. During the call, it was noted that Examiner Harrison is out on leave, but that, based on the body of the rejection, Examiner Harrison appears to have rejected claims 26-43.

Examiner Tung did not see any reason for rejecting claims 19-22 under 35 U.S.C. § 101. Thus, agreement was reached that the Office Action includes a typographical error in that the rejection under 35 U.S.C. § 101 is in fact of claims 26-43, not claims 19-22. In addition, agreement was reached that amending claim 26 to read "A software product tangibly embodied in a machine-readable storage device", rather than "A software product tangibly embodied in a machine-readable medium", would overcome the rejection. Without conceding the propriety of the rejection of claim 26, this claim has been amended to clarify the statutory nature of the claimed subject matter. Thus, withdrawal of the rejection under 35 U.S.C. § 101 is respectfully requested.

Rejection of Claims - 35 U.S.C. §§ 102 & 103:

Claims 1-43 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by US Pat. No. 6,239,792 to Yanagisawa et al. Claims 11 and 36 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Yanagisawa et al. in view of US Pat. No. 7,006,711 to Dresevic et al. These contentions are respectfully traversed.

Independent claim 1 recites, among other things, "detecting a backward motion between a first and a second location in the path if the first location's tracking zone overlaps with the second location's tracking zone." The Office appears to equate the "erasure area" of Yanagisawa et al. with the claimed "tracking zone", stating, "the coupling of erasure area indicates erasure along a trace of input points, where erasure indicates backward motion along

the trace” and citing to column 4, lines 18 to 32, and column 6, lines 57-62.¹ However, Yanagisawa et al. do not describe detecting a backward motion along the trace of input points defining an erasure area.

Yanagisawa et al. describe a technique for controlling the erasure area associated with a trace when erasing previously drawn points, lines, characters or images made up of such:

If a user selects the erasure mode, CPU 5 converts input information from the pen 1b into erasure information to be used for erasing points, lines, or characters or images made of points and lines respectively displayed on LCD 3, sets an erasure area, and changes the erasure area while detecting a motion speed of the pen 1b. In this manner, CPU 5 controls to erase the information in the erasure area as if the pen 1b operates like an eraser. CPU 5 also controls to erase information in the area along the trace of the pen 1b by coupling erasure areas corresponding to consecutive input points.²

Yanagisawa et al. further describe that the size of the erasure area is changed in response the speed of the pen, which can be determined based on only two consecutive input points:

The erasure area has a predetermined size per one input point of the pen 1b, for example, it is a circle area having a predetermined radius whose center is the input point. [...] In erasing information in the area along the trace of the pen 1b by coupling erasure areas corresponding to consecutive input points, one erasure area, for example, a circle erasure area, and the next circle erasure area are coupled by tangent lines or the like to define an erasure area of the trace. [...] The erasure area size is changed with the motion speed of the pen 1b. [...] The erasure area may be set for each line segment between two consecutive points instead of each input point. In this case, the erasure area may be set as a square

¹ See 12-20-2007 Office Action at page 3.

² See Yanagisawa et al. at col. 4, lines 11-20.

defined by two line segments spaced apart from, and having the same length as, the line segment between two consecutive points.³

Nothing in these portions, or any other portion of Yanagisawa et al. describe detecting a backward motion between a first and a second location in the path if the first location's tracking zone overlaps with the second location's tracking zone, as recited in claim 1. Thus, independent claim 1 should be in condition for allowance.

Similar arguments are applicable the other independent claims. In particular, Yanagisawa et al. do not describe "a backward motion detector that specifies a tracking zone for each location in the path based on the location and a previous location preceding the location along the path, and detects a backward motion if two of the specified tracking zones overlap", as recited in claim 19. Yanagisawa et al. do not describe "means for detecting a backward motion between a first and a second location in the path if the first location's tracking zone overlaps with the second location's tracking zone" as recited in claim 23. Yanagisawa et al. do not describe "detecting a backward motion between a first and a second location in the path if the first location's tracking zone overlaps with the second location's tracking zone" as recited in claim 26. Thus, each of independent claims 19, 23 and 26 should also be in condition for allowance.

Dresevic et al. describe storing ink "in a data structure that includes a mapping of the ink's coordinates from one space to another."⁴ Dresevic et al. fail to cure the noted deficiency of Yanagisawa et al. Thus, each of dependent claims 11 and 36, as well as each of dependent claims 2-10, 12-18, 20-22, 24, 25, 27-35 and 37-73 should be patentable based on their respective base claims and the additional recitations they contain.

³ See Yanagisawa et al. at col. 4, lines 21-41, and col. 6, lines 57-62.

⁴ See Dresevic et al. at Abstract.

For example, claim 6 recites “specifying a tracking zone that is inside the influence region of the location and outside the influence region of the previous location.” The cited portions of Yanagisawa et al. (col. 4, lines 20-26, and col. 6, lines 5-25) describe the use of an erasure area or a drawing area (depending on the selected mode) having a specified shape, such as a circle, “square, ellipsoid, rhombus, and the like.” Nothing in Yanagisawa et al. describes specifying a tracking zone that is inside the influence region of the location and outside the influence region of the previous location, as recited in claim 6. Thus, claim 6 should be allowable for at least this additional reason. Similar arguments are applicable to dependent claims 31, 48 and 63.

Conclusion

The foregoing comments made with respect to the positions taken by the Examiner are not to be construed as acquiescence with other positions of the Examiner that have not been explicitly contested. Accordingly, the above arguments for patentability of a claim should not be construed as implying that there are not other valid reasons for patentability of that claim or other claims.

A formal notice of allowance is respectfully requested. In the absence of such, a telephone interview with the Examiner and the Examiner's supervisor is respectfully requested to discuss the independent claims of the present application in light of the art of record.

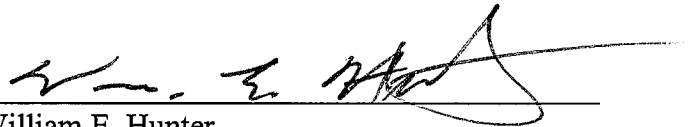
Applicant : Sambit Dash
Serial No. : 10/633,436
Filed : July 31, 2003
Page : 17 of 17

Attorney's Docket No.: 07844-601001 / P554

Please apply the \$1500 in excess claim fees, and any other necessary charges or credits,
to deposit account 06-1050.

Respectfully submitted,

Date: March 20, 2008



William E. Hunter
Reg. No. 47,671

Fish & Richardson P.C.
PTO Customer No. 21876
Telephone: (858) 678-5070
Facsimile: (858) 678-5099

10820156.doc